REMARKS

Claims 8-10 and 12-26 are pending.

Applicants request withdrawal of the finality of the July 15, 2004 final Office Action. The finality of the Office Action is premature because the Office Action is in response to amended claims filed with an RCE in response to the March 24, 2004 final Office Action. Therefore the finality of the July 15, 2004 Office Action is clearly improper on a first Action, as the amendments to the claims raised new issues.

The Examiner rejected claim 13 under 35 USC §102(b) as being anticipated by Condon et al., and claims 8-10, 12, and 14-26 under 35 USC §103(a) as being unpatentable over Condon et al. in view of Muni, stating that Condon teaches all the claimed subject matter, including a transparent shaft section proximal to a non-transparent balloon section (Fig. 7), and see col. 6, lines 32-36 for non-transparent balloon.

It should be noted that the term "proximal" in Condon et al. refers to the end of the catheter inserted into the patient (see col. 5, lines 10-15), which is opposite to the meaning of the term in Applicant's specification (unless otherwise noted, the terms "proximal" and "distal" are used here in Applicant's sense of distal being the end of the catheter furthest from the physician, i.e., the end inserted into the patient).

Condon et al. does not disclose a substantially transparent shaft section having a substantially transparent wall which extends around the circumference of the shaft and which is located proximal to a nontransparent shaft section. According to Condon, the Fig. 7 embodiment, referenced by the Examiner in the rejection of claim 13, is a nontransparent shaft with windows. However, the windows do not form a substantially transparent wall which extends around the circumference of the shaft as in claims 8 and 13, or a section which is substantially transparent around the circumference of the outer tubular member as in claim 22.

In the Response to Arguments section, the Examiner states that, contrary to Applicant's arguments, Condon discloses that the whole shaft or a portion of the shaft or a balloon can be made of a transparent material. However, Condon does not disclose or suggest a transparent section which 1) extends around a circumference of the shaft, and 2) is proximal to a nontransparent distal section of the shaft. Specifically, although Condon et al. does disclose embodiments in which the catheter shaft (i.e., "catheter 22/50") is transparent, there is no teaching or suggestion in Condon et al. of a catheter with a transparent proximal shaft section having a substantially transparent wall which extends around the circumference of the shaft, **and** with a nontransparent distal shaft section, as required by claims 8 and 13. Moreover, claim 13 requires that the inflatable member (e.g., balloon) on the distal section of the shaft, has a proximal end located distal to a distal end of the substantially transparent proximal shaft. Regarding claim 22, in Condon et al. the transparent shaft section is not a proximal section having an inner tubular member of the shaft located within the transparent section lumen (the inner tubular member defining a guidewire lumen in communication with a guidewire distal port at the catheter distal end).

Condon et al. discloses at col. 3, lines 16-18 that the catheter is partially or completely transparent. However, even if a "partially transparent" catheter refers to a catheter with part of the length of the shaft being transparent, that does not teach providing the transparent shaft section as set forth in the claims proximal to the nontransparent shaft section. Looking to the rest of the disclosure in Condon et al., Condon et al. only goes on to disclose embodiments in which the entire catheter shaft is transparent or windows are provided in at least a section of the catheter shaft, neither of which anticipates or renders obvious the embodiments set forth in Applicant's claims, as discussed above.

Moreover, Condon et al. teaches away from a catheter having the transparent section located proximal to the nontransparent section. Specifically, Condon et al. requires visualization "at least within the proximal 4-7 inches in order to permit

visualization of the structures comprising and adjacent the prostate" (see col. 3, line 39; and note that the term "proximal" in the quoted sentence refers to what Applicant's would call "distal"). Thus, there is no teaching or suggestion in Condon et al. for a nontransparent distal section (i.e., the end inserted into the patient) which is located distal to a transparent proximal section and which is transparent around the circumference of the shaft, as required in claims 8 and 13.

In light of the above remarks, Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

By: _____
Gunther O. Hanke
Registration No. 32,989

GOH:kh

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201